

**Application No. 10/566,111
Amendment dated March 11, 2009
Response to Office Action mailed December 11, 2008**

Amendments to the Drawings:

Applicant has added new Figure 22. Figure 22 shows the color tone setting window 100 with the ink color triangle 112 displayed in the color tone setting window. The attached sheet of new drawings has Figure 22 thereon.

Attachment: One (1) sheet of new drawings with Figure 22 thereon.

REMARKS

Claims 1, 2, and 4-19 are pending in this application.

Applicant has amended claims 1, 4, and 17-19, and has canceled claim 3. In addition, Applicant has made changes to the Title, the specification, and the drawings. As will be explained in more detail below, these changes do not introduce any new matter.

Allowable Subject Matter

Applicant appreciates the Examiner's prompt indication that claims 4-6 and 12 define allowable subject matter. Applicant's responses to the issues raised in the Office Action are set forth below.

Objection to the Drawings

In response to the objection to the drawings, Applicant has amended the drawings by adding new Figure 22, which shows the color tone window 100 with the ink color triangle 112 displayed in the color tone window. In addition, Applicant has amended the specification to include references to Figure 22 where appropriate. Support for the addition of Figure 22 and the references thereto in the specification can be found in Applicant's specification at, for example, Figures 5 and 6 and the accompanying description of these drawings in the specification. In light of the changes made herein, Applicant submits that the drawings now comply with 37 C.F.R. § 1.83(a) and requests that the objection to the drawings thereunder be withdrawn.

Objection to the Specification

In response to the objection to the specification based on the Title not being descriptive, Applicant has changed the Title to "Tone Setting for Monochrome Image Using Ink Color Diagram." Accordingly, Applicant requests that the objection to the specification be withdrawn.

Rejection Under 35 U.S.C. § 101

Applicant respectfully requests reconsideration of the rejection of claims 1 and 17 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. Applicant has amended each of claims 1 and 17 along the lines suggested by the Examiner. As such, Applicant believes that claims 1 and 17 now define statutory subject matter under 35 U.S.C. § 101, and requests that the rejection of these claims thereunder be withdrawn.

Rejection Under 35 U.S.C. § 102

Applicant respectfully requests reconsideration of the rejection of claims 1, 18, and 19 under 35 U.S.C. § 102(b) as being anticipated by *Sawamura et al.* (“*Sawamura*”) (US 5,012,299). Applicant has amended each of independent claims 1, 18, and 19 to include the features specified in original claim 3. In addition, each of claims 1, 18, and 19 has been amended to specify that “three vertices of the ink color triangle correspond to three chromatic primary colors of cyan, magenta, and yellow.”

As implicitly recognized by the Examiner, the *Sawamura* reference does not disclose each and every feature of the subject matter defined in present claims 1, 18, and 19.

Accordingly, claims 1, 18, and 19, as amended herein, are patentable under 35 U.S.C. § 102(b) over the *Sawamura* reference.

Rejections Under 35 U.S.C. § 103

Applicant respectfully requests reconsideration of the rejection of claims 2 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Sawamura* in view of *Samworth* (US 5,297,058). Each of claims 2 and 16 depends from claim 1. As noted above, claim 1 has been amended to include, among other features, the features of original claim 3. As implicitly recognized by the Examiner, the combination of *Sawamura* in view of *Samworth* would not have resulted in each and every feature of the subject matter defined in present claim 1.

Accordingly, claims 2 and 16 are patentable under 35 U.S.C. § 103(a) over *Sawamura* in view of *Samworth* for at least the reason that each of these claims depends from claim 1.

Applicant respectfully requests reconsideration of the rejection of claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Sawamura* in view of the *Horváth* publication and *Axelrod* (US 5,860,518) (as noted above, claim 3 has been canceled). As will be explained in more detail below, the combination of *Sawamura* in view of *Horváth* and *Axelrod* would not have rendered the subject matter defined in independent claim 17, as amended herein, obvious to one having ordinary skill in the art.

Applicant has amended claim 17 to specify that “three vertices of the ink color triangle correspond to three chromatic primary colors of cyan, magenta, and yellow.” This feature is neither disclosed nor suggested by either *Horváth* or *Axelrod*.

In Figure 1(E) (see page 3283), *Horváth* shows a color triangle having three vertices of red, green, and blue, which are not the three chromatic primary colors of cyan, magenta, and yellow. In Figure 2-A, *Axelrod* shows a color triangle having three vertices of red, blue, and yellow, which are not the three chromatic primary colors of cyan, magenta, and yellow. Thus, neither *Horváth* nor *Axelrod* teaches or suggests an ink color triangle having three vertices that correspond to the three chromatic primary colors of cyan, magenta, and yellow.

Further, Applicant respectfully submits that both *Horváth* and *Axelrod* are non-analogous art relative to the claimed subject matter. The *Horváth* publication relates to color perception of insects. The *Axelrod* reference relates to an artist’s paste case and its color arrangement. Neither of these references is within Applicant’s field of endeavor, i.e., the setting of a color tone for a monochrome image to be printed by a color printer. Moreover, neither reference is reasonably pertinent to the problem of setting a color tone for a monochrome image to be printed by a color printer. As such, both *Horváth* and *Axelrod* should be considered non-analogous art relative to the claimed subject matter.

In view of the foregoing, even if the *Sawamura*, *Horváth*, and *Axelrod* references were to be combined in the manner proposed by the Examiner, the result of this combination would not have included each and every feature of the subject matter defined in present claim 17.

As such, the combination of *Sawamura*, *Horváth*, and *Axelrod* would not have rendered the subject matter defined in present claim 17 obvious to one having ordinary skill in the art.

To the extent that the rejection of original claim 3, which has been canceled herein, might be considered applicable to independent claim 1, Applicant notes that the arguments set forth above regarding present claim 17 also generally apply to present claim 1.

Accordingly, independent claims 1 and 17, as amended herein, are patentable under 35 U.S.C. § 103(a) over the combination of *Sawamura* in view of *Horváth* and *Axelrod*.

Applicant respectfully requests reconsideration of the rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Sawamura* in view of *Okawara et al.* (“*Okawara*”) (US 5,317,678). Claim 7 depends from claim 1. As noted above, claim 1 has been amended to include, among other features, the features of original claim 3. As implicitly recognized by the Examiner, the combination of *Sawamura* in view of *Okawara* would not have resulted in each and every feature of the subject matter defined in present claim 1. Accordingly, claim 7 is patentable under 35 U.S.C. § 103(a) over *Sawamura* in view of *Okawara* for at least the reason that this claim depends from claim 1.

Applicant respectfully requests reconsideration of the rejection of claims 8-11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Sawamura* in view of the *Oken et al.* publication. Each of claims 8-11 and 13 ultimately depends from claim 1. As noted above, claim 1 has been amended to include, among other features, the features of original claim 3. As implicitly recognized by the Examiner, the combination of *Sawamura* in view of the *Oken et al.* publication would not have resulted in each and every feature of the subject matter defined in present claim 1. Accordingly, claims 8-11 and 13 are patentable under 35 U.S.C. §

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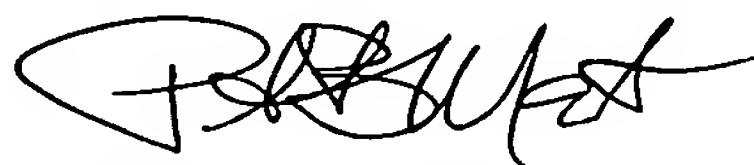
103(a) over *Sawamura* in view of the *Oken et al.* publication for at least the reason that each of these claims ultimately depends from claim 1.

Applicant respectfully requests reconsideration of the rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Sawamura* in view of *Shimada* (US 2003/0038870 A1). Each of claims 14 and 15 ultimately depends from claim 1. As noted above, claim 1 has been amended to include, among other features, the features of original claim 3. As implicitly recognized by the Examiner, the combination of *Sawamura* in view of *Shimada* would not have resulted in each and every feature of the subject matter defined in present claim 1. Accordingly, claims 14 and 15 are patentable under 35 U.S.C. § 103(a) over *Sawamura* in view of *Shimada* for at least the reason that each of these claims ultimately depends from claim 1.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1, 2, and 4-19, as amended herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP180).

Respectfully submitted,
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